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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,645	02/23/2004	Joseph P. Errico	SPINE 3.0-437 CPCPCPCPCPC	8190
51640 SPINE MP LERNER, DAVID, et al. 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090	7590 07/29/2010		EXAMINER PELLEGRINO, BRIAN E	
			ART UNIT 3738	PAPER NUMBER
			MAIL DATE 07/20/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/784,645

Applicant(s)

ERRICO ET AL.

Examiner

Brian E. Pellegrino

Art Unit

3738

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 3/16/10

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 3/16/10 have been fully considered but they are not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicants state Zucherman does not have a bent distal end and Grunberg does not include an extendible and retractable pin. In this instance, the orientation of an engaging feature is what the Examiner has relied on by Grunberg to modify because Zucherman discloses a tool with an extendible and retractable pin **40** of which the engaging portion of element **157** is what the Examiner has modified. It is noted that the pin element (157) of Zucherman's retractable pin (**40**) extends off of the retractable pin (**40**) in a coaxial arrangement since it does not lie on the same axis as rod portion (**40**) but is coaxially offset. Thus, if one were to categorize the portions of element (157) on Zucherman's tool, the engaging portion does extend parallel with the axis of the pin (**40**), but Grunberg suggests that pins can be arranged perpendicular to the axis of the tool such that it can engage recesses in plates of an implant. Thus, a prima facie case of obviousness has been established.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-16,19,20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 recites the "pin located partially *internal* the shaft along the longitudinal axis and being extendible and *retractable* along the longitudinal axis of the shaft, the pin including a distal end that is bent downwardly..." and then that "the *distal end* of the holding pin is prevented *from being entirely* retracted within the shaft". If some of the distal end is retractable within the shaft, how is this possible when it perpendicularly bent downward?

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 14-16,19,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zucherman et al. (6712819) in view of Shearer et al. (2004/59343) and Grunberg et al. (WO 02/071986). Zucherman et al. show (Fig. 2) apparatus for manipulating an orthopedic device having a shaft **20** with an extension **30** including a confronting surface **145** substantially perpendicular to the shaft longitudinal axis. It can also be seen there is a holding pin **157** bent downward and coupled with rod **40** such that it is located internal to the shaft. There is also a spring **125** coupled to the rod of the pin and configured to

bias the distal end of the pin inward and outward. Additionally, Zucherman discloses a flange **112** mechanically coupled to the rod of the pin that when pressure is exerted on the flange distally, it overcomes the spring-load of the spring to space the pin from the extension. Zucherman also discloses the surface of the extension prevents the bent downward pin from being entirely retracted therein, col. 6, lines 29-31. However, Zucherman et al. fail to disclose locating at least a portion of the spring internal to the shaft. Shearer et al. teach (Figs. 29-31) a shaft **28** having a spring **82** internally located to controllably deliver a prosthesis. The spring enables manipulation or control of rod **12** or elongate pin coupled to the spring. It would have been obvious to one of ordinary skill in the art to modify the spring location to be internal the shaft as taught by Shearer et al. with the prosthesis inserter of Zucherman et al. such that it provides more control with manipulation or placement of the prosthesis in the patient. Regarding claims 15,16 Zucherman discloses (Figs. 8b,8c) plates **800** with baseplate holes **806** for receiving pins of the tool. Additionally, while Zucherman does the pin or rod **40** and its engaging part **157** is oriented such that being bent down has its *engaging end* perpendicular to the axis of the shaft. Grunberg et al. teach (Fig. 4c) that a tool for delivering an implant to the spine has a retractable rod with a pin at the distal end that is perpendicular to the shaft. Grunberg et al. teach that the pin **410** is designed to engage holes or recesses that are perpendicular to the axis of the shaft of the tool, Page 18. Grunberg also illustrates (Fig. 8) the engagement of such a pin in a recess of a baseplate. It would have been obvious to one of ordinary skill in the art to modify the pin of the tool of Zucherman as modified with Shearer and to place it in a perpendicular orientation or

bent downward such that it matches or engages the hole or recess of baseplate for spinal surgery as taught by Grunberg et al. With respect to claims 19, 20, it is noted that Zucherman discloses a knob coupled to the shaft that is rotatable and is threaded thereto, Figs. 5, 6. Shearer also teach a rotatable knob for use of the delivery tool. Grunberg additionally teaches (Fig. 4a) that a knob (414) for rotation of a shaft to move the distal end.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on M- F (7am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TC 3700
/Brian E Pellegrino/
Primary Examiner, Art Unit 3738